

REMARKS

Upon entry of the present Amendment the Claims under consideration are 18, 22-30, 32-34, 52, 56, 58-64, 66-68, 71-72, 75-76, 80-82 and 86-88.

All Claims under consideration have been amended hereby to place the claims in better form for consideration on appeal. The subject matter of the amended claims is supported by the specification as filed, and at least by the original claims as filed therein. No new matter is added hereby. Entry of the present amendment is respectfully requested.

The Detailed Action of 14 January 2005 will now be addressed with reference to the headings and any paragraph numbers therein.

Claim Rejections -35 USC §103

Per paragraph 2 of the Detailed Action, Claims 18, 22-25, 29, 32-34, 52, 56-59, 63, 66-68, 80-82, and 86-88 stand as obvious over Assarsson *et al.* (U.S. Patent 3,901,236, hereinafter Assarsson) in view of Dodge, II *et al.* (U.S. Patent 5,994,615, hereinafter Dodge) and further in view of Veith *et al.* (U.S. Patent 5,516,569, hereinafter Veith) as set forth in paragraph 6 of the previous Office Action. Applicants therefore incorporate and reiterate their remarks of Amendment C with respect to these rejections.

A *prima facie* case of obviousness has not been made because the Examiner has not considered the present invention as a whole but instead has impermissibly considered the present invention to be nothing more than a combination of generic elements known in the art. As evidenced by the remarks in the final Office Action, the nature of the art and the specific structure of the claimed inventions as a whole has been ignored or considered as an abstraction in making the present rejections. The Examiner has not established a *prima facie* case of obviousness for the specifically claimed subject matter when considered as a whole. The Examiner has instead interpreted the invention, and applied the cited references, at a level of generality which does not account for the realities of the art and the inventive aspects of the present claims.

It is known, by definition, to a person of ordinary skill in the art that a surge material is designed to acquire and spread fluid, while absorbent materials are meant to retain fluid. It is irrelevant to a determination of obviousness (as asserted by the Examiner) that both surge and absorbent materials can be efficaciously used in absorbent "articles." Their functions, and hence their structures, must be considered separately. Applicants are not

claiming a generic and undefined “article.” They are claiming an absorbent web of specific structure. It is further irrelevant to a determination of obviousness (as asserted by the Examiner) that: “Dodge teaches the use of the particular bicomponent fibers in absorbent materials such as airlaid pads.” “Airlaid” is merely a method of producing nonwoven material. Absorbent materials may be airlaid (such as the present invention), but airlaid materials need not be absorbent (such as the surge material of Dodge).

Applicants have therefore correctly noted that even during an impermissible hindsight reconstruction of the present invention from the elements of the cited references, the teachings of fibers for a nonabsorbent surge material within Dodge cannot reasonably be used to suggest the present invention.

Per paragraph 6 the Examiner states that the rejections are not based on treating coated superabsorbent particles and uncoated superabsorbent particles as interchangeable, and asserts that “the rejection sets forth that … it would have been obvious to have increased the amount of superabsorbent particle used in Assarsson as taught by Veith, in order to form a thinner material.”

The motivation as supplied by the Examiner for such a substitution, i.e., to derive a “thinner material,” cannot serve as a *prima facie* rationale to support the combination of references because a person of ordinary skill in the art cannot assume that substituting a wetted (and thus swollen) superabsorbent particle (as in Veith) for a dry fluff (as in Assarsson) will necessarily result in a thinner material.

Further, this parsing of Veith’s teachings of amount and type of superabsorbent is a sophistry, since of course Veith teaches a concentration of uncoated superabsorbent particle (mixed with 15-30% water and optionally some fibrous material) and does not suggest the amount and type of superabsorbent are independent. A simple one-for-one substitution of concentrations for uncoated superabsorbent particle into a matrix of binder and particulate-coated superabsorbent material cannot be predictive of a useful absorbent structure since it ignores the considerable differences between these two types of absorbent materials and also ignores the differences in construction between the absorbent structures using those materials. For example, Assarsson is airlaid without mention of wetting. Veith requires a concentration of uncoated superabsorbent particle mixed with 15-30% water (and optionally some fibrous material).

Further, because a valid obviousness determination for the increase of concentration of coated superabsorbent particle in Assarsson to the levels of Veith requires some expectation of success, and none is presented in the cited art, a *prima facie* case of obviousness fails further.

In paragraph 7, the Examiner contends with respect to absorbency capacity: “since the references teach the claimed components and provide the motivation to combine the components to form an absorbent material, it is the examiner’s position that one of ordinary skill in the art would have been able to control the properties of the material through the choice of particular amounts, placement and materials employed.” [emphasis added] However, this contention is incorrect. While the Examiner may have found the “claimed components” in the references, no proper motivation to combine the components to create the claimed invention as a whole can be found in the art.

At best the Examiner has applied an impermissible “obvious to try” standard. It is established that the test for obviousness is not whether a person having ordinary skill in the art has the capability to arrive at the invention, but is whether the person having ordinary skill in the art would be motivated to arrive at the invention based on the teachings of the prior art. “At best, the Examiner’s comments regarding obviousness amount to an assertion that one of ordinary skill in the relevant art would have been able to arrive at appellant’s invention because he had the necessary skills to carry out the requisite process steps. This is an inappropriate standard for obviousness. . . . That which is within the capabilities of one skilled in the art is not synonymous with obviousness.” *Ex parte Levengood*, 28 USPQ2d 1300 (BPAI 1993).

Further, per the above discussion, Applicants have shown that no reasonable suggestion or motivation can be found within the cited references themselves to combine the components to form the structure of the claimed invention when considered as a whole. Any suggestion comes from a *post hoc* reconstruction reliant on a level of abstraction unavailable to a person of ordinary skill in the art who must construct a viable absorbent structure. Further, as discussed above, control of the absorbency properties, or any physical properties of an absorbent web, depend on many inter-related factors. The sheer amount of these factors would preclude a *prima facie* conclusion of “able to control” in this determination of obviousness.

It is clear from all the foregoing that the Examiner has merely performed a

hindsight reconstruction of the presently claimed inventions by pointing to generally known components within the art. However, none of the cited references reasonably provide a suggestion of the motivation for, or desirability of, the combination of these ingredients necessary to achieve the improvements in functionality brought forth by the claimed structure of the present invention.

Applicants have further pointed to many differences in the teachings of the references which negate the suggestion that the materials and construction techniques of Assarsson, Veith, and Dodge are interchangeable with each other or those of the present invention when properly considered as a whole, comes not from the art, but entirely from the Examiner.

Per paragraph 3 of the Detailed Action, Claims 26-28, 60-62, 71-72, and 75-76 stand as obvious over Assarsson in view of Dodge and Veith and further in view of Radwanski *et al.* (U.S. Patent 4,939,016, hereinafter Radwanski) as set forth in paragraph 7 of the previous Office Action. Applicants reiterate their above remarks with respect to the lack of a *prima facie* case of obviousness based on the Assarsson, Dodge and Veith references. Radwanski provides no further motivation to a person having ordinary skill in the art to place meltblown fibers in the web of Assarsson merely because Radwanski teaches meltblown fibers in its absorbent web.¹ The Detailed Action's proffered motivation of adding meltblown fibers to Assarsson in order to achieve enhanced esthetics is incorrect because the cited passage of Radwanski (i.e., col. 5) attributes its enhanced esthetics to the hydraulic entangling process and not to the use of meltblown fibers. Therefore, one of ordinary skill in the art would not add meltblown fibers to the web of Assarsson on the expectation of aesthetic enhancement.

It is further noted that the present Detailed Action has not addressed Applicants' remarks that Claims 70-72 and 75-76 are drawn to support members for the claimed composite web. The passages cited by the previous Detailed Action (i.e., col. 8+) deal with "additional layers added prior to hydroentangling" (see col. 9, line 11) and are not analogous to the support members taught and claimed in the present invention (e.g., at page 9, line 17).

Per the above discussion, none of the references, singly or in combination, teach or suggest the present invention. Therefore it is respectfully requested that all of the

¹ Meltblown and elastomeric binder fibers are the subject of Claims 26-28 and 60-62, but not Claims 70-72 and 75-76.

outstanding rejections be withdrawn.

Examiner Interview Summary

A telephonic interview was conducted on 16 February 2005 between Examiner Elizabeth Cole and Applicants' undersigned attorney. The nature of the claim language "about" was discussed. No agreement was reached concerning the allowability of the claims under consideration. Applicants' attorney would like to thank the Examiner for the courtesy shown him during their interview.

Conclusion

Per Applicants' above discussion, a reasonable interpretation of the invention as a whole² as set forth in the present Claims, and as informed by the specification of the application and the level of ordinary skill in the art, has not been made in applying the present rejections. Reasonable interpretations of the cited art teachings and of the present invention as a whole, and a proper comparison between the two, cannot sustain the present rejections.

The Examiner has impermissibly used the individual limitations of the present claims as a template³ to improperly select and combine numerous unrelated teachings of the cited references in determining obviousness, rather than viewing the present invention (and the cited references) as a whole. The actual teachings of the cited art do not reasonably teach or suggest the present invention as a whole.⁴ Therefore, a *prima facie* case of obviousness has not been made.

In light of all the foregoing discussion, it is requested that all of the present rejections be reconsidered and removed. The Claims as presently presented are believed to be allowable over the art of record. A notice to that effect is earnestly solicited.

Request For Telephonic Interview

The Examiner is requested to call Applicants' attorney (per the provisions of M.P.E.P. § 713) to discuss any further problems or suggest solutions in defining the present invention in order to expedite the case towards allowance before issuing a further Office Action.

2 It is well established that the invention must be considered as a whole. See e.g., Lear Siegler, Inc. v. Aeroquip Corp., 221 USPQ 1025, (Fed. Cir. 1984).

3 The principle of not using the claimed invention as an instruction manual or template to deprecate the claimed invention is well established. See, e.g., *In re Fritch*, 23 USPQ 2d 1780 (Fed. Cir. 1992).

4 It is also well established that the teachings must stem from the prior art (and not arise *post hoc* from the

Favorable consideration is requested.

Respectfully submitted,



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reader of the claims). See e.g., *In re Geiger*, 2 USPQ 2d 1276 (Fed. Cir. 1987).